

REMARKS

In the Final Office Action¹, the Examiner rejected claims 8-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,289,314 to Matsuzaki et al. ("*Matsuzaki*") in view of U.S. Patent No. 5,995,838 to Oda et al. ("*Oda*").

Applicants respectfully traverse the rejection of claims 8-13 under 35 U.S.C. § 103(a). The prior art cited by the Examiner, *Matsuzaki* in view of *Oda*, does not teach or suggest each and every element of claims 8-13. A *prima facie* case of obviousness has, therefore, not been established.

Claim 8 recites an information processing system including, for example:

at least one information processing apparatus . . .
a control apparatus . . . and
a master information processing apparatus . . . including . . .
a first transmitter . . .
a first receiver . . .
a second transmitter . . . and
a second receiver to receive registration conditions from said control apparatus, said registration conditions prepared in response to receiving said payment information from the master information processing apparatus that settles payment for media contents received directly by said at least one information processing apparatus,
wherein the first receiver and second receiver each contains a registration list that stores information about the corresponding receiver and determines which receiver is eligible for proxy account settlement.

(emphasis added). Neither *Matsuzaki* nor *Oda* disclose each and every element of Applicants' claimed invention.

According to the Examiner, the claimed at least one information processing apparatus corresponds to terminal 3 of *Matsuzaki*, and both the control apparatus and

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

master information processing apparatus correspond to server 2 of *Matsuzaki* (Office Action at pages 2-3). The Examiner cites Fig. 2, ref. 211, 221, 222, 223, for “a second receiver to receive registration conditions from said control apparatus” (Office Action at page 4). Applicants respectfully disagree.

The Examiner states that the master information processing apparatus in *Matsuzaki* corresponds to server 2 (Office Action at page 3). However, the second receiver, characterized by the Examiner as referring to ref. 211, 221, 222, 223 of Fig. 2, receives “CONTRACT INFO” from the transmitting station (Office Action at page 4). As shown in Fig. 2, however, the transmitting station TS is separate from the server 2, characterized by the Examiner as corresponding to both the control apparatus and the master information processing apparatus. Information received by ref. 211, 221, 222, 223 of Fig. 2 is received from the transmitting station TS, not the server 2. Because this information is received from the transmitting station TS, it is not received from either the control apparatus or the master information processing apparatus. Therefore, *Matsuzaki* does not teach any information processing system comprising “a second receiver to receive registration conditions from said control apparatus, said registration conditions prepared in response to receiving said payment information from the master information processing apparatus”, as recited in claim 8.

Moreover, *Matsuzaki* does not teach or suggest a “registration list” contained in both the first receiver and the second receiver. Therefore, *Matsuzaki* does not teach any information processing system comprising a first and second receiver wherein, “the first receiver and second receiver each contain a registration list that stores information

about the corresponding receiver and determines which receiver is eligible for proxy account settlement,” as further recited in claim 8.

The Examiner states that *Matsuzaki* “does not teach wherein the first receiver and second receiver each contain a registration list that stores information about the corresponding receiver and determines which receiver is eligible for proxy account settlement” (Office Action at page 4). The Examiner relies on col. 5, lines 44-59, of *Oda*, for allegedly teaching this limitation. Applicants respectfully disagree.

Oda discloses “a mobile communication apparatus which can perform two-way communication with reduced power consumption” (col. 1, lines 39-41). The apparatus includes “a determiner for determining whether the mobile communication apparatus exists within or outside the wide one-way communication area based on a received signal of the wide area receiver” (col. 1, lines 56-59).

Col. 5, lines 44-59 of *Oda* describe steps that are taken if the user terminal is “out of the wide service area 101” (col. 5, lines 44-45). Processor 207 communicates with cell base station 104 “so that power controller 216 supplies power supply voltages to the receiver 205 and the transmitter 206” (col. 5, lines 47-49). Processor 207 “generates a channel change request . . . and causes the transmitter 206 to transmit location registration information including the communication change request to the nearest cell base station” (col. 5, lines 52-56). This process ensures that the proper station is used to maintain user terminal connection.

Oda discloses processor 207 and transmitter 206 that communicate a change request to a cell station to maintain service. These elements are not a “registration list.” Moreover, nothing in *Oda* suggests “proxy account settlement.” The receivers in *Oda*

are used for mobile communication through a cell base station, not for “proxy account settlement.” Therefore, *Oda* does not teach any information processing system comprising a first and second receiver wherein, “the first receiver and second receiver each contain a registration list that stores information about the corresponding receiver and determines which receiver is eligible for proxy account settlement,” as recited in claim 8.

In addition, the Examiner has not established the requisite motivation necessary to combine *Matsuzaki* and *Oda*. The Federal Circuit has noted that “virtually all [inventions] are combinations of old elements.” See e.g., *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (internal citations omitted). The Federal Circuit has explained that an Examiner may find every element of a claimed invention in the prior art, but mere identification is not sufficient to negate patentability. *Id.* The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.*

Also, determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001), 59 USPQ2d 1693, 1696-98 (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. See *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002), 61 USPQ2d 1430, 1433 (quoting

McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52). Additionally, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be “clear and particular.” *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Office Action does not show that a skilled artisan considering *Matsuzaki* and *Oda*, and not having the benefit of Applicants’ disclosure, would have been motivated to combine the references in a manner resulting in Applicants’ claimed combination. The Examiner merely provided descriptions of how the references allegedly teach certain features without providing “clear and particular” reasons why a skilled artisan “would select the elements from the cited prior art references for combination in the manner claimed.” See *In re Dembicziak*, 175 F.3d at 999, 50 USPQ2d at 1617; *In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1457.

For example, the Examiner alleged “[i]t would have been obvious for such modifications because the registration list enables a mobile device to roam from a wide service area to a cell base station” (Office Action at page 5). The Examiner has not shown that one of ordinary skill in the art would have been motivated to combine *Matsuzaki* and *Oda*, viewing only teachings from within these references themselves, in a manner resulting in Applicants’ claimed invention.

The fact that *Matsuzaki* and *Oda* each disclose receivers and transmitters does not constitute a motivation for one of ordinary skill in the art to combine *Matsuzaki* and *Oda*. *Matsuzaki* discloses a pay information processing system to calculate and obtain charge based on use situations (col. 3, line 45 - col. 4, line 8). *Oda* discloses a mobile communication apparatus that performs two-way communication (col. 3, line 45 - col. 4,

line 8). Neither the references nor the Examiner's statements provide motivation for combination. Even assuming that a registration list enables a mobile device to roam from a wide service area to a cell base station, which Applicants do not concede, there must be motivation for using the registration list with the system of *Matsuzaki*. The Examiner has stated motivation for a registration list, allegedly disclosed in *Oda*, to enable roaming, also allegedly disclosed in *Oda*. However, the Examiner has not established motivation to modify *Matsuzaki* with the teachings of *Oda*. Even if a registration list enables roaming, *Matsuzaki* is not concerned with enabling a device to roam from one area to another. Nothing in *Matsuzaki* suggests a need to enable roaming. Absent motivation in *Matsuzaki* to look to the teachings in *Oda*, no motivation for combining the references exists.

Therefore, a *prima facie* obviousness also has not been established, for at least the reason that the requisite motivation to modify *Matsuzaki* and *Oda*, from within the references themselves, is lacking. In the rejection, the Examiner has not shown that one of ordinary skill in the art, when considering *Matsuzaki* and *Oda*, and not having the benefit of Applicants' disclosure, would have been motivated to modify and/or combine these references in a manner resulting in Applicants' claimed invention. The Examiner's allegation of motivation is without merit, and does not include any explanation as to how one of ordinary skill in the art would have modified *Matsuzaki* and *Oda* to produce all the elements of independent claim 8.

Applicants also direct the Examiner's attention to M.P.E.P. § 2143.01, which makes clear that: "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the

desirability of the combination” (citations omitted). The Examiner has not shown that *Matsuzaki* and *Oda* “suggests the desirability” of their combination. Thus, there would have been no motivation to combine these references. For at least these additional reasons, a *prima facie* obviousness has not been established regarding independent claim 8.

Applicants also note that “[i]n determining the differences between the prior art and the subject matter defined by the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02 (*citing Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)). Here, the Examiner has not shown that the subject matter defined by independent claim 8, as a whole, would have been obvious in view of *Matsuzaki* and *Oda*.

Accordingly, *Matsuzaki* and *Oda* fail to establish a *prima facie* case of obviousness with respect to claim 8. Thus, claim 8 is allowable for at least these reasons. Claims 9-12 are also allowable at least due to their depending from claim 8. Independent claim 13, while of different scope, recites limitations similar to those of claim 8 and is thus allowable over *Matsuzaki* and *Oda* for at least the same reasons discussed above in regard to claim 8.

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: /David W. Hill/
David W. Hill
Reg. No. 28,220